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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/504,978	02/15/2000	Curtis Ohrt	M-8039 US	8399

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EXAMINER

PASS, NATALIE

ART UNIT PAPER NUMBER

3626

DATE MAILED: 04/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/504,978

Applicant(s)

OHRT

Examiner

Natalie A. Pass

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 January 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the amendment filed 13 January 2003. Claims 1-23 remain pending.

Drawings

2. The objection to the drawings under 37 CFR 1.84(a) and 37 CFR 1.83(a) is hereby withdrawn due to the amendment filed 13 January 2003.

Claim Rejections - 35 USC § 112

3. Claims 1-23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention for the same reasons given in the prior Office Action (paper number 5, section 5, pages 3-4), incorporated herein.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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5. Claims 1-3, 5, 6, 12-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tyler, Jr. et al., U.S. Patent Number 5, 523, 942 in view of McClelland et al, U.S. Patent Number 5, 689, 650, for substantially the same reasons given in the previous Office Action (paper number 5). Further reasons appear hereinbelow.

(A) Claims 1-3, 5-6, 12-23 have not been amended and are rejected for the same reasons given in the previous Office Action (paper number 5, section 7, pages 4-10), and incorporated herein.

6. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tyler et al, U.S. Patent Number 5, 523, 942 in view of McClelland et al, U.S. Patent Number 5, 689, 650 as applied to claim 1 above, and further in view of Adunuthula et al, U.S. Patent Number 6, 026, 404, for substantially the same reasons given in the previous Office Action (paper number 5). Further reasons appear hereinbelow.

(A) Claim 4 has not been amended and is rejected for the same reasons given in the previous Office Action (paper number 5, section 8, page 10), and incorporated herein.

7. Claims 7, 9, 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tyler et al, U.S. Patent Number 5, 523, 942 in view of McClelland et al, U.S. Patent Number 5, 689, 650 as applied to claim 1 above, and further in view of Batz et al, U.S. Patent Number 5, 918, 022, for substantially the same reasons given in the previous Office Action (paper number 5). Further reasons appear hereinbelow.

(A) Claims 7, 9, 11 have not been amended and are rejected for the same reasons given in the previous Office Action (paper number 5, section 9, pages 11-13), and incorporated herein.

8. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tyler et al, U.S. Patent Number 5, 523, 942 and McClelland et al, U.S. Patent Number 5, 689, 650 in view of Batz et al, U.S. Patent Number 5, 918, 022, as applied to claim 7 above, and further in view of Narayanan , et al, U.S. Patent Number 5, 689, 664, for substantially the same reasons given in the previous Office Action (paper number 5). Further reasons appear hereinbelow.

(A) Claim 8 has not been amended and is rejected for the same reasons given in the previous Office Action (paper number 5, section 10, page 13), and incorporated herein.

9. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tyler et al, U.S. Patent Number 5, 523, 942 and McClelland et al, U.S. Patent Number 5, 689, 650 in view of Batz et al, U.S. Patent Number 5, 918, 022, as applied to claim 7 above, and further in view of Adunuthula et al, U.S. Patent Number 6, 026, 404, for substantially the same reasons given in the previous Office Action (paper number 5). Further reasons appear hereinbelow.

(A) Claim 10 has not been amended and is rejected for the same reasons given in the previous Office Action (paper number 5, section 11, page 14), and incorporated herein.

Response to Arguments

10. Applicant's remarks filed 13 January 2003 have been fully considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in the response filed 13 January 2003.

(A) At page 4 of the 13 January 2003 response, Applicant argues that although the preamble recites a product rate calculation system it is unnecessary for the claim limitations to clearly indicate a product rate calculation system. Applicant has not changed the claim language to make it clear which element of the claim performs the rate calculation recited in the preamble - does the claimed "product application" or the claimed "first support software" component or the claimed "first protocol stack" perform the act of "product rate calculation"? The cited claims fail to interrelate essential elements of the invention and therefore fail to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Further, Applicant's remarks apparently suggest that the "calculation of a product rate" is not what the Applicant seeks patent protection for. As such, why is it recited within the claim?

(B) At pages 5-9 of the 13 January 2003 response, Applicant argues that the claimed features of the application are not taught or suggested by the applied references. In response, all of the limitations which Applicant disputes are missing in the applied references, including the features discussed by Applicant in the 13 January 2003 amendment, have been fully addressed

by the Examiner as either being fully disclosed or obvious in view of the collective teachings of the cited references, based on the logic and sound scientific reasoning of one ordinarily skilled in the art at the time of the invention, as detailed in the 35 USC § 103 rejections given in the preceding sections of the present Office Action and in the prior Office Action (paper number 5), and incorporated herein. In particular, Examiner notes that the limitations of a "product rate calculation system including a product application operable to provide product information to and receive consumer information from a user and further operable to send a call to a product rate calculation software component" and a "first support software component operable to receive the call, and a first protocol stack operable to process the call" are taught by the cited references. For example, as noted at pages 4-5 of paper number 5, Tyler teaches a product rate calculation system (Tyler; column 4, line 65 to column 5, line 10) comprising: a product application operable to provide product information to and receive consumer information from a user (Tyler; column 5, lines 32-41), and further operable to send a call to a product rate calculation software component (Tyler; Figure 1B, column 5, lines 11-18, column 11, lines 33-36); a first support software component operable to receive the call from the product application (Tyler; column 5, lines 18-32) and McClelland teaches a first protocol stack operable to process the call into a protocol for transmission over a communication link (McClelland; column 20, line 65 to column 21, line 19).

(C) At pages 5-9 of the 13 January 2003 response, Applicant analyzes the applied references separately and argues each of the references individually.

In response to Applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In addition, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

In response to Applicant's argument that there is no suggestion to combine the references, the Examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

And modern case law has clearly and explicitly held that in order for the references to be combined the references need not explicitly teach or suggest every element of the combination as well as how to use such a combination. For example, the Court in *In re Fritch* stated "[The Examiner] can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that

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individual to combine the relevant teachings of the references. [emphasis added]" *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ 2d 1596, 1598 (Fed. Cir. 1988) (citing *In re Lalu*, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1988)). Each applied reference does not expressly suggest combination with the other respective references; however, both the Board and the Examiner have shown that motivation for combining the references existed in the prior art. The "modification" referred to in *In re Fritch* involves extensive changes to the primary references. Such is not the case in the present combinations, where all modifications proposed by the Board and the Examiner are taught by the references and that knowledge generally available to one of ordinary skill in the art. Therefore, the combination of references is proper and the rejection maintained.

Furthermore, the Examiner recognizes that references cannot be arbitrarily altered or modified and that there must be some reason why one skilled in the art would be motivated to make the proposed modifications. And although the motivation or suggestion to make modifications must be articulated, it is respectfully submitted that there is no requirement that the motivation to make modifications must be expressly articulated within the references themselves. References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures, *In re Bozek*, 163 USPQ 545 (CCPA 1969).

The Examiner is concerned that the Applicant apparently ignores the mandate of the numerous court decisions supporting the position given above. The issue of obviousness is not determined by what the references expressly state but by what they would reasonably suggest to one of ordinary skill in the art, as supported by decisions in *In re Delisle* 406 Fed 1326, 160

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USPQ 806; *In re Kell, Terry and Davies* 208 USPQ 871; and *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ 2d 1596, 1598 (Fed. Cir. 1988) (citing *In re Lalu*, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1988)). Further, it was determined in *In re Lamberti et al* 192 USPQ 278 (CCPA) that:

- (i) obvious does not require absolute predictability;
- (ii) non-preferred embodiments of prior art must also be considered; and
- (iii) the question is not express teaching of references but what they would suggest.

According to *In re Jacoby*, 135 USPQ 317 (CCPA 1962), the skilled artisan is presumed to know something more about the art than only what is disclosed in the applied references. In *In re Bode*, 193 USPQ 12 (CCPA 1977), every reference relies to some extent on knowledge of persons skilled in the art to complement that which is disclosed therein. In *In re Conrad* 169 USPQ 170 (CCPA), obviousness is not based on express suggestion, but what references taken collectively would suggest.

In the instant case, the Examiner respectfully notes that each and every motivation to combine the applied references is accompanied by select portions of the respective reference(s) which specifically support that particular motivation. As such, it is NOT seen that the Examiner's combination of references is unsupported by the applied prior art of record. Rather, it is respectfully submitted that explanation based on the logic and scientific reasoning of one ordinarily skilled in the art at the time of the invention that support a holding of obviousness has been adequately provided by the motivations and reasons indicated by the Examiner, *Ex parte Levengood* 28 USPQ 2d 1300 (Bd. Pat. App. & Inter., 4/22/93).

As such, it is respectfully submitted that Applicant appears to view the applied references separately and in a vacuum, without considering the knowledge of average skill in the art, and further fails to appreciate the breadth of the claim language that is presently recited.

(D) At pages 5-9 of the 13 January 2003 response, Applicant apparently argues that a prima facie case of obviousness has not been established.

In response, the Examiner respectfully submits that obviousness is determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Hedges*, 783 F.2d 1038, 1039, 228 USPQ 685,686 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785,788 (Fed. Cir. 1984); and *In re Rinehart*, 531 F.2d 1048, 1052, 189 USPQ 143,147 (CCPA 1976). Using this standard, the Examiner respectfully submits that the burden of presenting a prima facie case of obviousness has at least been satisfied, since evidence of corresponding claim elements in the prior art has been presented and since Examiner has expressly articulated the combinations and the motivations for combinations that fairly suggest Applicant's claimed invention (see paper number 5). Note, for example, the motivations explicitly stated at lines 13-15 of page 5 of the previous Office Action (i.e., "...with the motivation of providing a user interface for the network serving as a link ...") and at lines 18-21 of page 10 of the prior Office Action (i.e., "...with the motivation of isolating the software from the complexities of inter-machine communication and allowing its use in a highly distributed system without being distribution aware... ").

Rather, Applicant does not point to any specific distinction(s) between the features disclosed in the references and the features that are presently claimed. In particular, 37 CFR 1.111(b) states, "A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the reference does not comply with the requirements of this section." Applicant has failed to specifically point out how the language of the claims patentably distinguishes them from the applied references. Simply stated, what distinctions, if any, are there between Applicant's recited product rate calculation system including a product application operable to provide product information to and receive consumer information from a user and further operable to send a call to a product rate calculation software component, a first support software component operable to receive the call, a first protocol stack operable to process the call, and the corresponding elements of the Tyler and McClelland references? Also, arguments or conclusions of Attorney cannot take the place of evidence. *In re Cole*, 51 CCPA 919, 326 F.2d 769, 140 USPQ 230 (1964); *In re Schulze*, 52 CCPA 1422, 346 F.2d 600, 145 USPQ 716 (1965); *Mertizner v. Mindick*, 549 F.2d 775, 193 USPQ 17 (CCPA 1977).

In response to Applicant's argument that the Examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the Applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Conclusion

11. **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. **Any response to this final action should be mailed to:**

Box AF

Commissioner of Patents and Trademarks

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or faxed to:

(703) 305-7687.

For formal communications, please mark

"EXPEDITED PROCEDURE".

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For informal or draft communications, please label
"PROPOSED" or "DRAFT" on the front page of the
communication and do NOT sign the communication.

Hand-delivered responses should be brought to Crystal Park 5,
2451 Crystal Drive, Arlington, VA, Seventh Floor (Receptionist).


13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Natalie A. Pass whose telephone number is (703) 305-3980. The examiner can normally be reached on Monday through Thursday from 9:00 AM to 6:30 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas, can be reached at (703) 305-9588. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 308-1113.

NP

Natalie A. Pass

April 17, 2003


JOSEPH THOMAS
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